

REMARKS

Claims 1-53 have been previously cancelled without prejudice. Claim 55 has been canceled without prejudice. Claims 54 and 56-71 are pending.

The Office Action rejected claims 54 and 56-65 and 67-71 as being obvious over Fritzsich (5,441,499) in view of Witt et al. (2002/0107517). The Office Action also rejected claim 66 as being obvious over Fritzsich (5,441,499) in view of Witt et al. (2002/0107517) and Swanson 6,123,702.

The Examiner is respectfully thanked for withdrawing the previous rejections of the claims.

Applicants agree that Fritzsich fails to anticipate the independent claims of this case. However, the Office Action suggests that Fritzsich only lacks a light connected to a power source in order to meet the limitations of applicants' independent claims. The Office Action cited MPEP 2144.04 V in support of this statement. We respectfully disagree.

MPEP 2144 states, "... if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court." MPEP 2144.04 V states: *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952) (Fact that a claimed device is portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results.).

Thus, the Office Action is taking the position that the facts of *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952) are sufficiently similar to those of the present application to render the claims per se obvious. We respectfully disagree. The rationale used by the court in the *Lindberg* case is inapplicable to the facts of the present application.

The Lindberg case included a power sprayer adapted to be mounted on farm machinery such as a cultivator or tractor for use in spraying crops. In contrast, applicants claim a medical device having a specific structure, a battery and a light. There is nothing in Lindberg that remotely suggests that it is per se obvious to add a battery and light to a

medical device as suggested in the Office Action. Thus, applicants respectfully submit that reliance on this MPEP section is misplaced and the rejection must be withdrawn.

Claim 71 further recites that the rounded tip portion is free of any electrode movable relative to the rounded tip portion. In contrast, Fritzsich discloses a device with a movable electrode. This further distinguishes claim 71 from the claimed combination and is an independently sufficient reason that claim 71 is patentable over the cited art.

Witt et al. does not cure the deficiencies of Fritzsich. In Witt et al., the feedback light 327 is lit when a complete circuit is made between electrodes 342, 344, 346, 348 leads 351, 353, 355, 357, tissue 354 and generator 312, by a capacitive coupling. See paragraph [0091]. The indicator light dims upon dessication of the tissue. Thus the light 327 is designed to work with a power source in a generator that is not a battery. Even if the cited disclosure were combined with Fritzsich, the combination would still fail to teach the limitations of “a power source comprising a battery;” and “a light located on the medical device and electrically coupled to the power source;” of claims 54 and 71.

Swanson also does not cure the deficiencies of Fritzsich and DeWitt. Thus, claim 66 is allowable as well for the reasons set forth above.

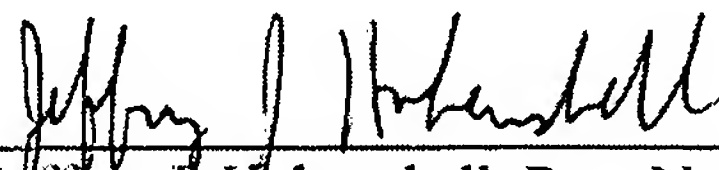
A supplemental information disclosure statement accompanies this response. Please charge the fee of \$180 for such SIDS to Deposit Account No. 13-2546.

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If the Examiner comes to believe that a telephone conversation may be useful in addressing any remaining open issues in this case, the Examiner is invited to contact the undersigned agent at 763-505-8426.

Respectfully submitted,

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